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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/246,468 02/09/99 REBEK

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EXAMINER

GARCIA, M

ART UNIT

PAPER NUMBER

1627

DATE MAILED:

10/01/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action

Application No.
09/246,468

Applicant(s)
Rebek et al

Examiner
Maurie E. Garcia, Ph. D.

Art Unit
1627



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Sep 11, 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires SIX months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for the reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on Sep 11, 2001. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search. (See NOTE below);
 - (b) ☐ they raise the issue of new matter. (See NOTE below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE:

4. ☐ Applicant's reply has overcome the following rejection(s):

5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in separate, timely filed amendment cancelling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:
Please see attached.

7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
Claim(s) allowed: _____
Claim(s) objected to: _____
Claim(s) rejected: 1-15
9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
11. ☐ Other:

ADVISORY ACTION
Attachment

1. The Remarks filed September 11, 2001 have been fully considered but were not found persuasive. The examiner's rationale is set forth below.
2. Applicant again argues that the instant invention has utility, pointing to several places in the specification. At every instance, these statements in the specification are general, not specific. For example, the cited page 4, lines 14 & 15: "the present invention provides a core molecule for use in constructing a combinatorial library". As stated in the rejection, an asserted utility must be specific, not general. The statement of the utility must fully and clearly explain why the applicant believes the invention is useful.
3. As also stated in the rejection (see previous Office Action, paragraph 8):

With respect to the individual compounds, it is clear that the specification discloses no specific exploitable biological (or other) activity for any of the compounds that would render them of an immediate benefit to the public. The specification suggests that libraries of such compounds be screened for such activity, but does not report that any of the compounds possess an exploitable activity. On the contrary, whether any of the compounds possess such an activity is entirely speculative. Indeed, it is possible, according to the specification as a whole, that none of the compounds will turn out to have any useful activity. Applicants have left to others this burden of determining by means of screening whether any of the compounds will amount to more than mere objects of scientific inquiry. Therefore, as to the individual compounds, there is no disclosed specific utility.
4. See also the following from the previous Office Action (paragraph 9):

On the second level of analysis, the claimed use of the compounds as core molecules for constructing a combinatorial library also would not provide an immediate benefit to the public as such is not a specific asserted utility. The specification states that the benefit that the libraries provide the public is their usefulness as "research tools." See the specification, at page 13, lines 12-13, and elsewhere: "A combinatorial library of this invention is useful for rapidly generating and developing large numbers of drug candidate molecules." While research tools have long been recognized as being patentable subject matter, there


is also a well-recognized distinction between research tools and the objects of research. Thus, while telescopes, microscopes, gas chromatographs, screening assays, and the like, are examples of research tools that enjoy unquestioned utility (MPEP 2107(I) second column), chemical entities, with no disclosed (and no generally well known) useful activity do not.

5. Lastly, applicant states (Remarks, page 2, last three sentences) that "the Examiner has not established a *prima facie* showing that the claimed invention has no credible utility". As stated in the previous Office Action, in footnote 2:

Note, because the claimed invention is not supported by a specific asserted utility for the reasons just set forth, credibility cannot be assessed.

Thus, no assessment as to the credibility of the utility has been made.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurie E. Garcia, Ph.D. whose telephone number is (703) 308-0065. The examiner can normally be reached on Monday-Thursday from 9:30 to 7:00 and alternate Fridays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat, can be reached on (703) 308-2439. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.


DR. JYOTHSNA VENKAT PH.D
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

Maurie E. Garcia, Ph.D.
September 27, 2001